



PATENT
Customer No. 22,852
Attorney Docket No. 06502.0435

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Bruce Tognazzini) Confirmation No.: 8272
Application No.: 08/655,136) Group Art Unit: 3621
Filed: May 30, 1996) Examiner: Calvin L. Hewitt II
For: CATALOG PHONE SALES)
TERMINAL)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-GRANT APPLICATION FOR PATENT TERM ADJUSTMENT

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 1188 days, to bring the total patent term extension up to 1569 days. This application is being filed with the issue fee payment, as required by 37 C.F.R. § 1.705(b).

I. Statement of the Facts Involved

A. Correct Patent Term Extension

Applicant received the Determination of Patent Term Adjustment with the Notice of Allowance and Fee(s) Due mailed from the Patent and Trademark Office (PTO) on October 12, 2005, stating that this application is entitled to 381 days of patent term

adjustment. However, Applicant has calculated a patent term adjustment of 1569 days as follows.

The above-identified application was filed on May 30, 1996, and was the subject of two successful appeals to the Board of Patent Appeals and Interferences. Thus, the resulting patent will be entitled to extension of its term due to the delay associated with appellate review by the Board as set forth in 37 C.F.R. § 1.701(a)(3). The period of delay is the sum of the number of days beginning on the date of the filing of the Notice of Appeal and ending on the date of a final Board decision in favor of Applicant, pursuant to 37 C.F.R. § 1.701(c)(3). Furthermore, according to 37 C.F.R. § 1.701(d), the period of delay must be reduced by (1) any part of the appellate review that occurred within three years of the application filing date; and (2) any part of the appellate review during which Applicant failed to act with due diligence.

First Successful Appeal

The first Notice of Appeal was filed on November 25, 1998 with a supporting Appeal Brief filed on January 25, 1999. The Examiner's Answer followed on March 29, 1999, and a Decision on Appeal issued on August 3, 2002. The Decision on Appeal reversed all of the Examiner's claim rejections, so it reversed an adverse determination of patentability as set forth in 37 C.F.R. § 1.701(a)(3).

The period of delay associated with this first successful appeal is the sum of the number of days beginning on November 25, 1998 (i.e., the date the Notice of Appeal was filed) and ending on August 3, 2002 (i.e., the date of the final Board decision in favor of Applicant). 37 C.F.R. § 1.701(c)(3). However, this period of delay must be reduced by any time that occurred before May 30, 1999 (i.e., three years from the filing

date) and any time during which Applicant failed to act with due diligence. 37 C.F.R. § 1.701(d). During the period of appellate review, i.e., the time from the filing of the Notice of Appeal until the issuance of the Board's decision, Applicant timely filed all necessary papers and did not seek any extensions of time. Thus, Applicant does not believe that any reduction of the period of delay is necessary under 37 C.F.R. § 1.701(d)(2). Accordingly, the period of delay associated with the first successful appeal is 1,188 days (i.e., the period from May 31, 1999, to August 30, 2002).

Second Successful Appeal

In response to the first Decision on Appeal in Applicant's favor, the Examiner reopened prosecution, which continued until Applicant pursued a second appeal to the Board.

The second Notice of Appeal was filed on June 15, 2004, with a supporting Appeal Brief filed on August 13, 2004. The Examiner's Answer followed on January 25, 2005, and Applicant filed a Reply Brief on March 17, 2005. The Decision on Appeal issued on June 30, 2005, reversing the Examiner's rejections of claims 1, 15, 21, and 28. Thus, the Decision on Appeal reversed an adverse determination of patentability under 37 C.F.R. § 1.701(a)(3).

The period of delay associated with the second successful appeal is the sum of the number of days beginning on June 15, 2004 (i.e., the date the Notice of Appeal was filed) and ending on June 30, 2005 (i.e., the date of the final Board decision in favor of Applicant). 37 C.F.R. § 1.701(c)(3). None of this period of delay occurred before May 30, 1999 (i.e., three years from the filing date), and during the period of appellate review, Applicant timely filed all necessary papers and did not seek any extensions of

time. Thus, Applicant does not believe that any reduction of the period of delay is necessary under 37 C.F.R. § 1.701(d). Accordingly, the period of delay associated with the second successful appeal is 381 days (i.e., the period from June 15, 2004 to June 30, 2005).

Correct Patent Term Extension

For the foregoing reasons, the total patent term extension based on delay is 1,188 days for the first successful appeal and 381 days for the second successful appeal, resulting in a total patent term extension of 1,569. This term of extension does not exceed 1825 days, or five years. 37 C.F.R. § 1.701(b). Because the PTO calculated an extension of just 381 days, Applicant respectfully requests that the current patent term extension be reconsidered and corrected.

B. Terminal Disclaimer

The above-identified application is not subject to a Terminal Disclaimer.

II. Fee

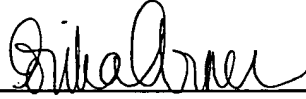
As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a check for \$200.00 to cover the required fee. Please charge any deficiencies to our Deposit Account No. 06-0916. If there are any other fees due in connection with the filing of this request, please charge them to our Deposit Account No. 06-0916.

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Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: December 29, 2005

By: 
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